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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,717	08/22/2001	Masahiro Imoto	1830/50325	6281

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EXAMINER

LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,717

Applicant(s)

IMOTO ET AL.

Examiner

Hong Liu

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-7 and 10-16 is/are rejected.
- 7) ☐ Claim(s) 8,17 and 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-8 and 10-18 are pending in this application.

This action is in response to the applicants' amendment and reply filed on March 23, 2004.

Response to Arguments

Applicants' arguments and amendments filed on March 23, 2004 have been fully considered but they are not persuasive. Rejections of Claims under 35 U.S.C. § 112, first and second paragraph are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. The amendment is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants fail to indicate whether the compounds in claim 18 are disclosed by the specification. Claim 18 has no generic concept such that it is difficult to determine whether the compounds in claim 18 are within the same scope of the compounds in claim 1.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The rejection of claims under 35 U.S.C., 112, first paragraph, is hereby withdrawn in view of applicant's amendments.

Claims 1-7 and 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1). Claims 2 is a substantial duplicate of Claim 1, as the only difference is that the compounds of claim 2 can also serve as a modulator of nicotinic receptors. The claim is vague in that claim 1 recites the compound of formula I to be an activator whereas in claim 2, the compound can be an agonist and a modulator. A modulator may modulate a nicotinic receptor by increasing or decreasing its activities. Since the instant compounds are nicotinic receptor agonists as indicated in claim 1, they only tend to increase, rather than decrease, the activities of the nicotinic receptor. Clarification is required.

2). Because of the amendment of claim 2, it is unclear whether claim 1 is a compound claim or a composition claim. If it is considered as a composition claim as claim 2 is a composition claim and claim 2 depends from claim 1, then claims 2-7 are substantial duplicate of Claim 1, as the only difference for these claims is intended use which is not given material weight. Note *In re Tuominen* 213 USPQ 89.

3). Likewise, because of the amendment of claim 11, it is unclear whether claim 10 is a compound claim or a composition claim. If it is considered as a composition claim, then claims 11-16 are substantial duplicate of Claim 10, as the only difference is intended use which is not given material weight. Note *In re Tuominen* 213 USPQ 89.

The remaining rejections under 35 U.S.C. 112, second paragraph, are hereby withdrawn in view of the amendments.

Claim Rejections - 35 USC § 102

The rejection of claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Diehr et al., Chem Abstract 90: 71749 is hereby withdrawn in view of applicants' amendment of variable -Y-X.

Claim Rejections - 35 USC § 103

The rejection of claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over Latli et al. (US Patent 6,303,638) is hereby withdrawn. Applicants have provided a certified copy of the priority document and a translation of the priority document which shows that the present claims are adequately supported by the priority document and thus is entitled to the priority date, which predates the effective filing date of the patent ('638).

Claim Objections

Claims 8 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (571) 272-0669. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisors, Mukund Shah can be reached at (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 358-1235.


RICHARD L. RAYMOND
Mukund Shah
ART UNIT 1624
Supervisory Patent Examiner
Art Unit 1624

hl
May 12, 2004